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Paper No. 8

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In re Application of: James C. Thomas, Jr.	:	PETITION TO INVOKE
Application No. 09/927,296	:	SUPERVISORY AUTHORITY
Filed: August 10, 2001	:	UNDER
Attorney Docket No.: 45659/TJD/T503	:	37 C.F.R. 1.181
For: COMPUTERIZED SYSTEM FOR	:	
COMBINING INSURANCE COMPANY	:	
AND CREDIT CARD TRANSACTIONS	:	

This is in response to applicant's petition filed on August 19, 2003 to have the June 3, 2003 Office action withdrawn and to have a new Office action issued.

The petition is **DENIED**.

Petitioner's arguments are directed to two main issues. The first of these is the discrepancy between the International Preliminary Examination Report (IPER) and the June 3, 2003 Office action and the second issue is directed to the June 3, 2003 Office action being deficient.

With respect to the discrepancy between the IPER and the June 3, 2003 Office action, this argument goes to the patentability of the claims over the prior art, which is an appealable, and not a petitionable, matter and as such will not be addressed here. However, any decisions concerning patentability made in a PCT application are not binding upon a U.S. filed application.

Petitioner, with respect to the June 3, 2003 Office action being deficient points to several areas of concern. Petitioner argues that the rejection of claims 23-32 as being anticipated by Cummings is an omnibus rejection with no correlation of the claim limitations to the disclosure of the reference. Further, petitioner points to MPEP 707.07(d) to provide support for the position that claims shouldn't be grouped together in a single rejection unless the rejection is equally applicable to all of the claims. Also, that the examiner has failed to provide any factual or technical reasoning to support the inherency holding. Finally with respect to the rejection under 35U.S.C. 103(a) petitioner argues that the examiner has failed to develop a prima facie case in support of the

rejection. In this rejection, it is urged, that the claims were rejected without addressing any of the claim limitations.

A review of the file history indicates that the June 3, 2003 Office action contains a rejection for claims 23-32 under 35 U.S.C. 102(b) as being anticipated by Cummings, Jr. and the examiner goes on to explain how the reference reads on the basic concept of the claims. As for this being an omnibus rejection this is clearly not the case. It is clear from the rejection that the examiner has taken the position that all of claims 23-32 are anticipated by the Cummings Jr. reference. As such the requirement of MPEP 707.07(d) have been met. There is no requirement for the examiner to map each and every feature of the claims to the reference. For an anticipatory rejection the reference has to disclose all of the features set for in the claims. As to the examiner failing to identify any factual or technical reason for the holding of inherency, this in itself does not make the rejection wrong as long as the art can reasonably be interpreted to meet the claim limitations. If the petitioner is not in agreement with the examiners rejection under 35 U.S.C. 102 they have the right to argue this before the examiner and to challenge the holding of inherency by the examiner and to ultimately request a hearing before the Board of Patent Appeals and Interferences.

With respect to the rejection under 35 U.S.C. 103(a) the examiner has provided an explanation as to what is lacking in the base reference and further explains why it would have been obvious to modify the base reference. The rejection is clear and petitioner has the right to respond and to argue the features they feel are not disclosed by the references or why the base reference cannot be modified as suggested by the examiner.

Accordingly the petition is denied. Applicant's three month period for response to the June 3, 2003 Office action continues to run. The application will be forwarded to central files to await a response by applicant.

Any questions concerning this decision should be directed to Robert Olszewski at (703) 308-5183.

Summary: *Petition Denied*



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